

amended claim 10, claims 3 and 9-11 have been amended. Accordingly, it is respectfully requested that the amended claim is described in the specification in such a way as to enable one of ordinary skills in the art to make and/or use the invention and thus, the rejection under 35 U.S.C. §112, first paragraph, be withdrawn.

The Examiner next rejected claims 1-9, 12-20, and 23-26 under 35 U.S.C. §102(b) as being clearly anticipated by Schrader et al., U.S. Patent No. 5,903,881 and Dolphin, U.S. Patent No. 5,457,746. However, the arguments presented by the Examiner indicated that a rejection under 35 U.S.C. §103(a) as being unpatentable over Schrader in view of Dolphin was intended. Accordingly, applicant responds to the present rejection as if a rejection under 35 U.S.C. §103(a) was made. Schrader discloses an online banking system for the integrated and simultaneous display of three areas including a list of transaction instructions, uncleared transactions and cleared transactions. Schrader discloses a software module located on a customer computer to encrypt information. No encrypted information pertaining to a customer's financial account is provided on a computer-readable portable storage medium. Additionally, Dolphin discloses encrypted data on a CD-ROM, however, the data is not used to access a customer's financial account via a public network, it does not include information pertaining to a customer's financial account and a financial institution does not use the stored encrypted data to determine an access to the customer's financial account.

As to independent claims 1, 17 and 26 neither reference, individually or in combination, teach or suggest a computer readable portable storage medium having encrypted and unencrypted information recorded thereon *pertaining to said customer's financial account*. Nor do either reference teach or suggest individually or in

combination a decryption processor for *decrypting said encrypted information retrieved from said storage medium such that a financial institution, connected to said decryption processor via said private network, determines an access to said customer's financial account on the basis of the decrypted information.*

As to claims 2 and those dependent therefrom, neither reference, individually or in combination, teach or suggest a separate computer for hosting a site for goods or services to transfer an active module to said network access device in response to said customer requesting the access to said customer's financial account by using said computer-readable portable storage medium. Schrader teaches software module 304 residing on the customer computer, not on an independent computer.

Further, the Examiner states that it would have been obvious to combine the teachings of Schrader et al. and Dolphin to incorporate the security authentication and encryption protocol keys suggested by the Dolphin reference into the Schrader et al. banking system. However, the Examiner does not point to any specific motivation within the reference Dolphin himself.

Dolphin's stated motivation is to provide selective access to data stored on a CD-ROM, not transmission of encrypted data over a public network. The applicant submits that there is no motivation by Dolphin to make the suggested combination and that the results from the combination are unexpected because Dolphin fails to foresee the disclosed system and method for providing financial services over a public network and private network. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to

modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The U.S. Court of Appeals for the Federal Circuit restated the legal test applicable to rejections under 35 U.S.C. 103(a) (In re Rouffet, 47 USPQ2d 1453 (Fed. Cir., July 15, 1998)). The Court stated:

[V]irtually all [inventions] are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. The Board [of Appeals] did not, however, explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Instead, the Board merely invoked the high level of skill in the field of the art. If such a rote indication could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. Instead, in complex scientific fields, the Board could routinely identify the prior art elements in an application, invoke the lofty level of skill, and rest its case for rejection. To counter this potential weakness in the obviousness construct the suggestion to combine requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.

In re Rouffet, 47 USPQ2d 1457-58 (Fed. Cir., July 15, 1998) (citations omitted, emphasis added).

Therefore the applicant submits that the rejection of independent claims 1, 17 and 26, for obviousness lacks the requisite motivation and therefore must be withdrawn. Claims 2-16, 18-25 and 27-28 being dependent on claims 1, 17 and 26 respectively are also therefore be allowable.

The Examiner further rejected claims 10, 11, 21, 22, 27 and 28 under 35 U.S.C. §103(a) as being unpatentable over Schrader et al., U.S. Patent No. 5,903,881 in view of Motoyama, U.S. Patent No. 5,913,202 and Polcyn, U.S. Patent No. 6,195,357.

In so far as Schrader et al. is concerned, applicant submits that the arguments made above in connection with prior 103(a) rejection are applicable here for this obviousness rejection; therefore, applicant incorporates those remarks herein by reference. Specifically, Schrader et al. is defective in that the applied reference does not teach or suggest a computer readable storage medium encrypted and unencrypted information recorded theron pertaining to a customer's financial account.

The applied secondary references Motoyama and Polcyn are further removed from the claim invention as evidenced by the Examiner's reliance on the same for disclosing the subject matter of dependent claims 10, 11, 21, 22, 27 and 28. Moreover, Motoyama is defective in that the applied reference does not teach or suggest a *computer-readable storage medium having encrypted and unencrypted information recorded thereon pertaining to a customer's financial account wherein the unencrypted information includes an audio message pertaining to said customer's financial institution*. Polcyn is defective in that the applied reference does not teach or suggest a *computer-readable storage medium having encrypted and unencrypted information recorded thereon pertaining to a customer's financial account wherein the unencrypted information*

includes advertising information pertaining to said customer's financial institution.

Moreover, the Examiner does not point to any specific motivation within either reference to combine Motoyama or Polcyn with Schrader et al.

As discussed at length above, to establish a prima facie case of obviousness (1) there must be some suggestion or motivation to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference(s) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure, which would constitute improper hindsight.

Therefore the applicant submits that the rejection for obviousness lacks the requisite motivation and therefore must be withdrawn.

In view of the above, it is respectfully submitted that all of the claims in this application contain allowable subject matter and a Notice of Allowance is respectfully solicited.

CONCLUSION

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

The Commissioner is authorized to charge all required fees including any extension fees due, any additional fees or credit any overpayment to Deposit Account 06-0923. Enclosed is a duplicate copy of this sheet.

Respectfully submitted for Applicant,



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